

REMARKS

Formal Matters

In the specification, the paragraphs at page 15, lines 21-26 and page 38, lines 1-11 have been amended to conform with proper Trademark usage.

Claims 1-25, 28-81 remain in this application. Claims 26 and 27 have been canceled. Claims 1-23 and 29-38 have been withdrawn as the result of an earlier restriction requirement, but are pending a possible reconsideration by the Examiner for rejoinder with the non-withdrawn claims 24-25 and 28. Claims 1, 25, 28 and 35 are amended and new claims 39-81 are added. No new matter is added by the amendments. Support for the amendments is found generally throughout the specification, and specifically at least at the following locations:

Claims 1, 25 and 35:

- “introduced/engineered interface” - page 23, lines 14-20; page 9, lines 22-26; page 14, line 10 to page 15, line 16; page 38, lines 19-22;
- “protuberances/cavities” - page 9, lines 22-26; page 19, line 12 to page 22, line 2; page 23, lines 14-20; page 25, lines 9-16;
- “interface increasing yield of heteromultimer” - page 10, lines 18-21

Claim 41: page 25, lines 9-16.

Claims 42-43: page 35, line 4 to page 42, line 9.

Claim 44: page 22, lines 3-20.

Claims 60-65: Figures 6A-6B.

Claim 65: page 35, lines 9-12.

Claim 66: page 14, line 10 to page 15, line 20.

Claim 67: page 15, lines 17-20.

Claim 68: page 15, lines 17-20; page 18, lines 1-9.

Claim 69: page 15, lines 17-20; page 18, lines 10-14.

Claim 70: page 15, lines 17-20.

- Claim 71: page 15, lines 17-20.
Claims 72-74: page 16, lines 18-21.
Claims 75-80: page 18, lines 15-24.
Claim 81: page 18, line 25 to page 19, line 2.

Restriction and Election Requirements

Applicants hereby confirm provisional election of Group II, Claims 24-28. However, as the withdrawn claims are process claims and Applicants have currently elected composition of matter claims, pursuant to MPEP § 821.04, such process claims are further pending rejoinder with the elected composition of matter claims.

Newly added claims 39-81 are directed to the elected subject matter of Group II.

Judicially Created Double Patenting Rejection

Claims 24-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 5,821,333.

In response, the enclosed terminal disclaimer renders the rejection moot.

Rejection Under 35 U.S.C. § 101

Claims 24-27 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

In response, the proposed amendments render the rejection moot.

Rejection Under 35 U.S.C. § 102(b) (cited references)

Claims 24-28 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kostelny *et al.*, *J. Immunol.* 148: 1547-1553 (1992).

In response, the pending claims have been amended to recite that first and/or second polypeptides have been altered or engineered to create the engineered interface. Thus, the

Appl. No. 10/010,245

Patent Docket P0927C2

Amend. dated April 5, 2005

Response to Office Action mailed on: October 19, 2004

protuberances or cavities have been artificially engineered into the interface. Kostelny *et al.*, describes a naturally occurring interface which has not been engineered to into a protuberance and/or cavity as recited in the claims of the instant application.

Appl. No. 10/010,245
Amend. dated April 5, 2005
Response to Office Action mailed on: October 19, 2004

Patent Docket P0927C2

SUMMARY

Claims 1-25, 37-38 and new claims 39-81 are pending in the application.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a 3-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
GENENTECH, INC.

By: 

Craig G. Svoboda
Reg. No. 39,044
Telephone No. (650) 225-1489

Date: April 5, 2005

176130